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IN THE

Supreme Court of the United States

OCTOBER TERM 1963

No. [redacted] 146

BRYAN W. NICKERSON, JR.,

Petitioner,

vs.

THE BEARFOOT SOLE CO., INC.,
THE BEARFOOT AIRWAY CORP.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

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Petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Sixth Circuit, entered December 28, 1962.

OPINIONS BELOW

The District Court did not write an opinion but the Court's Findings of Fact, Conclusions of Law, and Judgment are part of the record before the Circuit Court of Appeals in the Appendix to Brief of Appellants on pages 139A, 143A, and 147A respectively. The opinion of the Circuit Court of Appeals is printed as an Appendix to this petition. No petition for a rehearing was made.

JURISDICTION

The jurisdiction of this Court is invoked under 28 U.S.C. Sec. 1254 (1) On March 26, 1963 Mr. Justice Stewart signed an order extending the time to file a petition for a writ of certiorari in this case to and including May 27, 1963.

JURISDICTION OF COURTS BELOW

This is a suit for patent infringement. Jurisdiction of the Federal Courts is founded on 28 U.S.C. Sec. 1338 and 1400.

CONSTITUTIONAL PROVISION, STATUTES, AND RULES INVOLVED

Article III, Sec. 1 of the Constitution of the United States:

> "The judicial Power of the United States, shall be vested in *one* Supreme Court, and in such inferior Courts as the Congress may from time to time ordain and establish."

U.S.C. 35, Sec. 251: Reissue of defective patents (First paragraph)

> "Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. *No new matter shall be introduced into the application for reissue.*" (Emphasis supplied.)

U.S.C. 35, Sec. 114. Models, specimens.

> "The Commissioner may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of his invention.
>
> When the invention relates to a composition of matter, the Commissioner may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment."

Patent Office Rule 91. Models not generally required as part of application or patent.

> "Models were once required in all cases admitting a model as a part of the application, and these models became a part of the record of the patent. Such models are no longer generally required (the description of the invention in the specification, and drawings, must be sufficiently full and complete, and capable of being understood, to disclose the invention without the aid of a model), and will not be admitted unless specifically called for."

QUESTIONS PRESENTED

1. Is it acceptable judicial procedure for a Circuit Court of Appeals to decide a case with complete disregard for the truth as found in the record, indicating thereby that adequate investigation was never made?[1].

2. Should a Circuit Court's opinion stand unreviewed that supports the premise that the patent grant be discriminately available only to those financially able to spend huge sums of money to develop and test the subject matter of the

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1. It should be noted that if a writ of certiorari is granted this case will be argued on the questions of validity and infringement on which the Circuit Court erred as a result of the above departure from propriety in deciding this case. Questions above and especially Question 1 are reasons why your Petitioner feels that a review by the Supreme Court is justified.

patent, and establish a criterion for patentability that is inequitable, unrealistic, and contrary to the law?

3. Can courts use words of a Primary Examiner in the Patent Office to support court's erroneous conclusions in invalidating a patent, when said words were subsequently found erroneous and were reversed by the Board of Appeals, and when said practice would, in effect, destroy an effective line of appeal in the Patent Office?

STATEMENT

Your Petitioner, Plaintiff, sued in the Trial Court Respondent, Defendant, Bearfoot Sole Co., Inc., et al, for infringement of Petitioner's patent No. Re. 24,518,[3] herein referred to as Petitioner's patent. Defendants, Bearfoot, were producing articles of manufacture as per Plaintiff Exhibits No. 1, 3, 5, 7, 9, of which Exhibits No. 2, 4, 6, 8, 10 are cross-sectional cuts thereof. The foregoing exhibits together with Plaintiff's Exhibit No. 26 are transferred to this court herewith. (Exhibits 1 thru 10 stipulated, see Appendix 12A)

Defendants are licensed and operating under Barnes Patent No. 2,621,979,[4] herein referred to as Barnes No. 1. Defendants claimed in defense that Petitioner's structure was inoperative, that claims 1 and 2 were not patentable over Barnes, Spencer[5] and Daniel.[6] Defendants also argued that reissue claim 3 was improvidently allowed and on infringement contended that Plaintiff Exhibits 1, 3, 5, 7, 9

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2. Guide regarding references of record. Appendix, followed by page number and letter A designates page in Appendix of Appellants in Circuit Court. Decision, followed by page and key number, designates location in the decision of the Circuit Court.

3. Appendix 81 A

4. Appendix 109A

5. Appendix 107A

6. Appendix 123A

used a different mode of operation than distortion by the inflated tire.

The suit was brought in the United States District Court for the Northern District of Ohio, Eastern Division. A judgment was filed February 9, 1961[7] in which the Findings of Fact[8] and Conclusions of Law[9] proposed by the counsel for the Plaintiff were adapted. The patent was found valid and infringed.

Defendants appealed the judgment to the Circuit Court of Appeals for the Sixth Circuit and in a decision filed December 28, 1962, the Circuit Court reversed the judgment of the Trial Court.

Facts re. Question 1[10]

Your Petitioner realizes that an erroneous decision, per se., does not necessarily warrant review by the Supreme Court. The very size of the docket necessitates stringent allowance of writs of certiorari. In this present case, however, there is much more involved than matters of opinion that may be flexed broad or narrow, but rather errors that indicate a judicial practice that is not compatible with justice, for how can there be justice when the decision does not reflect the truth? There is not involved here one single spectacular error, but a series of the subtle more dangerous errors that have the cumulative effect of eroding and thwarting justice. What is unbelievable to your Petitioner, a layman, is the fact that a Circuit Court of Appeals, that is expected by the public to exemplify propriety, prudence, and integrity, should issue out a decision so wanting for accuracy and truth. As a lesser example of these inaccuracies, the

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7. Appendix 147A
8. Appendix 139A
9. Appendix 143A
10. Petitioner regrets burdensome nature of comments, but feels they will aid in putting Question 1 in perspective.

Circuit Court reprinted cancelled claims word for word except the one part that really mattered, the patentable life of the claim. The qualifying phrase was omitted; this was compounded when the Court erroneously pointed out another phrase it held to be the qualifying phrase to support still another erroneous contention by the Court.[11]

So that the Supreme Court can better understand the significance of the errors made by the Circuit Court, your Petitioner respectfully asks the Court to read Barnes No. 1 (Appendix 109A) and Petitioner's patent (Appendix 81A). These two documents are the focal points on which the case turns.

The Petitioner's patent relates to an attachable white wall for automobile pneumatic tires.

For years and especially during World War II and the Korean War, when strategic materials precluded making white wall rubber tires, and they all but disappeared from the market, the industry had been *striving in vain* to provide a substitute white side wall. The very best the industry had to offer was a rigid plastic disc, white in color, that snapped onto the wheel—usually overlapping slightly the side wall of the tire—effecting a white wall tire. As soon as white wall tires became available again the white disc soon lost favor with the public. But the demand remained for a feasible, realistic, imitation white side wall that could be detachably mounted and exchanged from tire to tire as the tires wore out or as the owner wished. The demand persisted, however, mostly because to the average lower income automobile owner white side wall tires were priced prohibitively

To fill this need, then, required a side wall easily combined with existing wheel and tire assemblies, that could be made with a minimum of steps permitting a one-step operation, and providing a single molded structure that would assure low cost and mass production.

The one piece structure had to be elastic or resilient in nature so that a flat tire or tire striking the curb would not

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11 See error 12

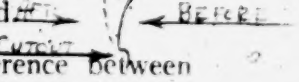
damage the side wall. Being resilient it had to have some means so that it would not flap out but remain inwardly toward the tire. In addition to all this, the side wall should appear to be a real white side wall tire at least from a short distance away. Filling this order, then, was no small chore.

The closest the prior art came to this solution is represented in patents to Daniel, Spencer, and Barnes, all cited as references. Spencer used a rigid construction, Daniel used glue, and Barnes used wire springs imbedded in the side wall running radially inwardly, bending nearly at right angles and projecting axially inwardly (see Barnes No. 1, Fig. 2, numeral 21). This spring and the manner in which it is bent and extends beneath the tire bead is why the Barnes' main body portion can maintain its position. The springs give the body portion a semi-rigid construction.

In this setting then; the need, the nature of the problem, and the state of the art as they all existed in 1951, the present invention was conceived. Conception was not easy. The present invention provided for the *first* time a single piece of resilient material that could be mass produced in one operation. The structure, that by its shape alone and without the aid of auxiliary means would maintain an inwardly pressure and not flap out away from the tire. A structure that provided a side wall that looked like a white side wall tire.

This was accomplished by departing substantially from the teachings of the prior art. The prior art as in Barnes and Daniel disclosed structures that were sinuous in cross section, rigid or semi-rigid in nature, and shaped to conform to the shape of the fully inflated tire as shown in Barnes No. 1 (, or as in Daniel.

The Petitioners' invention has a cross-sectional shape in which the body portion lends itself to being distorted by the inflating tire and due to the resilient properties of the material used resist this distortion. The two main points of departure from the prior art are as indicated.



Therefore the operative and novel difference between Petitioner's invention and prior art was that it had an arcuately shaped cutout 20 which followed the rim flange

12 around.[12] Barnes and Spence did not follow the rim flange around but parted somewhat in a radial direction in a smooth flowing curve.[13] The cutout of Petitioner's structure rested on the rim flange and assured that the body portion took its initial pre-distorted position.[14]

The other patentable and operative feature and departure from the prior art is the cross-sectional pre-distorted shape of the body portion.

If there is any doubt that the Petitioner's patent sufficiently teaches those skilled how to make the invention, please remember that the Defendants made the side wall from the patent and attempted to prove inoperativeness therewith. The District Court and Circuit Court found the structure operative.[15] Operativeness is not an issue here.

There is one aspect of this case that should be clarified, however, and that is the fact that this invention is difficult to disclose in that the invention actualy lies in a shape. The initial pre-distorted, cross-sectional shape of the side wall is in fact the invention. A shape, especially an *irregular* shape, that does not fall into the broad class of circles, squares, etc., is very difficult to put into words. The old saying: A picture is worth a thousand words is applicable here. For this reason the specification has relied in some instances on the drawing to disclose and define the shape.[16]

This could not be done in the claim, however, and claimology phrasing was used. The patentable and operative phrases in claims 1 and 2 are: "side wall being biased outwardly and frictionally embracing the tire when the tire is inflated" is a functional phrase supported by a structural phrase, after establishing the nature of the cutout, which is

12. See Petitioner's patent Fig. 2 and 5; also col. 1, lines 64-72, col 2, lines 36-38.

13. See Barnes No. 1 Fig. 2; also Spencer appendix 107A, Fig. 2.

14. Scientific principles are not required in patent disclosures, but to say that the cutout 20 resting on the rim would act as a catalytic agent between the lip which is anchored and the body portion which is being distorted, may help the Court understand the role and necessity of the Petitioner's arcuate cutout—lacking in prior art.

15. Decision, page 36, key 1.

16. Petitioner's patent, col. 2, lines 64-71

set forth: "cutout defining a hump providing vertex for the outer portion of the side wall." Taking the definition of vertex as found in the dictionary, we see that it is the highest point of the meeting of two sides. Taken in the light of the specification we see that the body portion in relation to the hump is in a position that is axially inwardly of that position it will take after inflation.

In reissue claim 3 the cutout is provided by the lip portion being, "arcuately recessed," and the pre-distorted shape is set out by the phrase: "the body portion having an unstressed cross-sectional shape defining a plane that is axially inwardly of the operating position of said body portion."

Therefore a novel and patentable invention has been provided, the statutory requirement for disclosure have been satisfied and examined not once but three different times and allowed. A valid patent issued.

In the light of the foregoing, then, let us examine what the Circuit Court said about validity and infringement.

Following are statements (in abstraction) of some of the erroneous holdings of the Circuit Court followed by quotations from the decisions that support these errors. Opposing facts are then pointed out that represent the truth of the case as found in the record indicating thereby that the Circuit Court did not dutifully determine the case on the facts.

Error 1: The holding by the Circuit Court that Barnes No. 1 anticipated the Petitioner's structure and disclosed a structure that lends itself to distortion, said anticipation specifically pointed out in the term: "turned inwardly."

In the decision: Page 8, key 2; page 11, key 3; page 28, key 4.

The truth: The above holding is an adaptation of a self-serving myth developed by the Defendants. Petitioner directs Court's attention to Barnes No. 1 claims 2 and 3 in which following phrase appears: "said annular body having its inner peripheral portion *turned inwardly* to form a skirt . . ." This finds support in the specification in col. 2, lines 4-9, which states: "Fixed securely to or formed integ-

rally with the inner periphery of the annular body 20 is a skirt 21 which is adapted . . ."

Let's review briefly how Barnes overcame the problem of the side wall flapping out. The body portion is provided with flat springs which are bent and turned axially inwardly to be included with the skirt as shown Fig. 2. The side wall and the springs are shaped to conform to the tire[17] and when the tire is inflated the side of the tire comes out to meet the annular body 20. This static relationship is maintained because the wire springs give the body portion a semi-rigid character. The key to this function is the bend in the wire and the fact that the springed skirt is wedged *under* the bead of the tire.

Compare this with the Petitioner's structure that has the cutout resting on the flange 12 and coacting with the body portion which is shaped, not to conform to the shape of the tire, but a pre-distorted shape so that it is distorted by inflating tire and assuming the shape thereof but resisting distortion

Therefore there is not even a remote possibility that Barnes No. 1 patent anticipates Petitioner's invention or that the phrase, "turned inwardly," is analagous to a structure lending itself to distortion.

Error 2: The contention or inference that activity by Defendants prior to the issuance of the Petitioner's patent somehow invalidates the novelty of said patent.

In the decision: Page 12, key 5.

The truth: The filing date of Petitioner's patent was April 24, 1951, and takes precedence over any activity by the Defendants by at least two years. The only possible meaning the Circuit Court's contention could have (which reflects Defendant's argument) is that the invention is obvious to those having *ordinary* skill in the art because they produced it on their own before the patent issued. It was Barnes, however, not Bearfoot who initiated the development of the side wall.[18]

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17. Barnes No. 1, col. 2, lines 2-4.

18. Appendix 32A-33A, Taylor, direct.

The side wall, if developed independently, of the teachings of the Petitioner's patent was conceived and developed by Barnes, the inventor, and not Bearfoot, or those with ordinary skill. It should be noted that Barnes has been granted approximately 5 or 6 patents on attachable side walls alone. So here is a man with an inventor's mind applying all his creative talent to the problem of providing a feasible imitation white side wall. If he solved it at that time it was not because it was obvious.

Another subsequent inventor, acting independently, to arrive at a similar solution does not invalidate the earlier conception as lacking novelty. If this contention by the Circuit Court were not corrected it would in effect invalidate every patent to issue out of interference proceedings in the Patent Office. For what are interferences but a form of trial in the Patent Office to determine who of two or more parties is entitled to a patent? Such proceedings do not endanger the novelty of the invention.[19]

There is another aspect of the case that is pertinent. Shortly after filing the application, Petitioner disclosed the invention to B. F. Goodrich & Co., and several other people. Theoretically, then, anyone could have gained, by indirect means, knowledge of the invention and produced it independently. This is one reason why interference laws exist.

There is a question as to the authenticity of the dates of Bearfoot's prior activity.[20] Mr. Taylor testified [21] that the Port-A-Wall (Barnes' tradename) was first produced about November 4, 1954. Yet Barnes himself stated in a sworn affidavit in the file wrapper of Barnes Patent No. 2,737,422, that:

> "I succeeded in getting production of my type of trim member started in the early part of 1955 . . ."

This discrepancy suggests a fabrication and cast a shadow of doubt on the entire case of Defendant's early activity and should be considered in that light.

19. In *Elliot & Co. v. Youngstown Car Mfg. Co.*, 181F 345, (3rd Circuit) Judge Archbald said: "The result of interference proceedings is not conclusive of invention in subsequent suit for infringement."

20. Appendix 135A, Chronology.

21. Appendix 35A.

Error 3: The holding by the Circuit Court that the patent was allowed on and the patentable novelty existed in the terms: cutout, hump, and flat portion.

In the decision: Page 11, key 6; page 29, key 7.

The truth: As pointed out earlier the patentable features as set forth in claims 1 and 2 were the arcualety shaped cutout defining a hump which provides a vertex for the outer or body portion.

The Circuit Court's comments in this respect are an unqualified adaptation of the argument by the Defendants and show a lack of understanding of the facts.

Error 4: The contention by the Circuit Court that the invention lacked patentable novelty.

In the decision: Page 32, key 8.

The truth: There is a great deal that could be said about this matter of novelty and the citations on obviousness, etc., would fill a volume. The invention disclosed is novel, however, and finds support for this in the law and precedence. Petitioner would like to cite some pertinent facts and cases and comment briefly on them.

As a historical fact and common knowledge to every male who lived and drove an automobile during World War II and the Korean War, white side wall tires all but disappeared from the market due to strategic war material in making of white rubber. This left a huge void and a demand to be filled by the industry. This demand continued, as stated earlier, to satisfy the low income owners. Therefore for twenty years before the solution by the Petitioner the industry strove, with intensified effort through two major wars, to provide a feasible, attachable, white side wall. Prior to the Petitioner's patent not one side wall had been made that used the before and after principle of distortion. Since the patent however, the acceptance of the solution is indisputable.

Judge Learned Hand in the case of *Lyon v. Bausch & Lomb*, 224 F 2nd 530, said:

> "The most competent workers in the field had for at least ten years been seeking a . . . . there had been a

number of attempts, none satisfactory; meanwhile nothing in the implementary art had been lacking to put the advance into operation; when it appeared it supplanted the existing practice and occupied substantially the whole field. We do not see how any combination of evidence could more completely demonstrate that, simple as it was, the change had not been obvious to a person having ordinary skill in the art." (See also *Feedman v. Overseas Scientific Corp.*, 150 Fed. Supp. 394; *Hotchkiss v. Greenwood*, 52 US 284; *Patent Royalties Corp. v. Land-O-Lakes Creameries*, 89 F 2nd 624).

Judge Hand could very well be speaking of the present case the circumstances are so similar. It is worth noting that the industry had general knowledge for attaching and providing a side wall,[22] it had the material, (the art of plastic molding could have provided a flexible plastic just as easily as it did rigid) the only thing lacking was the novel idea of so initially shaping the side wall in cross-section that it lends itself to distortion as provided by Petitioner's disclosure in patent in suit.

The prior art relied on springs, glue, or rigid construction to keep the body portion of the side wall from flapping out. Petitioner's side wall eliminated all of these heretofore necessary elements and achieved a result that was superior to the prior art. It is well established that the elimination of parts necessary to the prior art while maintaining the same result may be invention of the highest order.[23]

In regards to whether or not the Petitioner's invention was obvious to those having ordinary skill in the art, the solution viewed in retrospective always belittles the inventive effort. The Supreme Court in the case of *Goodyear Tire & Rubber Co., Inc., et al, v. Ray-O-Vac Co.*, 321 US 593, said:

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22. British Patent No. 401, 345, Appendix 127A.

23. Walker on Patents, Deller's Edition, page 207, Sec. 39, the case of *Stow v. Chicago* was cited in which Judge Blodgett said: "A construction of a machine, so that a less number of parts will perform all functions of the greater, may be invention of a high order, . . ."

"The fact that, viewed after the event, the means patentee adapted seems simple as such and should have been obvious to those who worked in the field, is not enough to negative invention."

Error 5: The view that the Patent Office Board of Appeals erred in reversing the Primary Examiner in that the Board never noticed that cancelled claim 4 was a combination claim and should have been a bar, instead of cancelled claim 3, to allowance of the reissue claim 3.

In the decision: Page 25, key 9.

The truth: The above is an adaptation of the Defendant's argument that the Board of Appeals made a mistake and *never noticed* that cancelled claim 4 was a combination claim and should have been a bar to a subsequent combination claims. The Board in its first decision[24] mentions the fact that the application was filed containing subcombination and combination claims therefore was well aware of cancelled claim 4. Board did not agree with Examiner that subject matter, "curved inwardly", was a bar to allowance; Board's reason was that now subcombination claims were not obtainable in reissue in view of earlier cancellation.

Error 6: The Circuit Court has expended a great deal of time and words to support the false premise that the term, "turned inwardly," as used in Barnes No. 1; or, "curved inwardly," as found in cancelled claims of Petitioner's patent defines a side wall that has a cross-sectional shape that lends to distortion.

In the decision: Summed up in statements: Page 11, key 3; page 14, key 11.

The truth: The feature referred to as, "turned inwardly," as found in the Barnes No. 1 has been covered in Error No. 1. Petitioner will not burden the Court by repeating it here except to say that the term as used in Barnes No. 1 is so far removed from defining a distortion prone side wall, that one wonders what the Circuit Court had in mind when it adapted this very misleading argument by the Counsel for the Defendants.

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24. Decision, page 24, key 10.

Regarding the "curved inwardly" as used in cancelled claims 3 & 4, this term was applied to the peripheral edge[25] and not the side wall as stated by the Circuit Court.[26]

When the Petitioner's side wall was filed in (1951) white side walls had a radial width that extended beyond the point of widest bulge of the tire.[27] This meant that the peripheral portion or edge would have to curve inwardly to better conform to the shape of the tire. This was also true of the Barnes No. 1 and Daniel who both had peripheries that curved inwardly yet neither structure was distorted by the inflated tire. A peripheral edge curved inwardly, therefore, does not define a structure that lends to distortion. Yet the Circuit Court repeatedly referred to a *side wall* curved inwardly and held that it defined a distorted structure when in truth the phrase of record was *peripheral edge* curved inwardly. The two are not interchangeable.

Error 7: The holding by the Circuit Court that the Defendant's side wall, Plaintiff's Exhibits 1, 3, 5, 7, 9, are physical embodiments of the structure disclosed in Barnes No. 1.

In the decision: Page 6, key 14; page 12, key 15; page 31, key 16.

The truth: A study of the Barnes No. 1 as seen in Fig. 2 shows a cross-section like this . The Defendant's structure as best seen in Plaintiff's Exhibits 2, 4, 6, 8, 10, are shaped like this . The side wall as found in Barnes No. 1 is static, i.e., it does not change shape in being distorted by the inflating tire, but the Defendant's structure does as is plainly noticeable from the exhibits. Further proof is found in Fig. 6 of Barnes later patent No. 2,737,422, (Appendix 113A) in which he clearly shows the before and after distorted position.

Further, the anchoring means of the Defendant's side wall is a radial skirt; the Barnes No. 1 anchor is an axially turned inward skirt held *beneath* the tire bead.

If one were asked to locate the features of the Barnes No. 1 in the Defendant's side wall, he would be hard put to find

25. Decision, page 7, key 12.
26. Decision, page 8, key 13.
27. Petitioner's patent Fig 2.

even one point of resemblance outside of the fact that both structures are attachable side walls.

Error 8: The statement by the Circuit Court that the invention was not recorded until September 26, 1957.

In the decision: Page 23, key 17; page 29, key 18.

The truth: In any reissue prosecution the most stringently kept law by the Patent Office is the one stating: "No new matter may be introduced into the application for reissue."[28]

The essence referred to by the Circuit Court is directed at a comment made by the Petitioner during prosecution of the reissue and is in reference to the qualifying phrase: "body portion defining a plane . . . ," which was the patentable spark for that particular claim 3. This qualifying phrase had support in the original application *as filed*.[29]

The essence then was recorded when filed in 1951 and not 1957.

Error 9: The statement by the Circuit Court that the Patent Office never realized that it allowed the patent, or was actually aware of what the allowance was granted on.

In the decision: Page 29, key 19.

The truth: Having prosecuted a few patent applications, Petitioner is knowing of the fact that in the early days of the prosecution the Examiner will state a great many reasons why the claim should not be allowed, but eventually, if applicant persists and patentable matter is present, the Examiner will allow the claims. In doing so, however, he seldom says why and just lets the allowance speak for itself. It's the old saying that actions speak louder than words.

In addition, the length of time the patent was prosecuted in the Patent Office, the number of times it was examined and re-examined and then reviewed by the Board of Appeals, leaves no doubt as to either the validity or the features responsible for allowance.

Error 10: The presumption by the Circuit Court that Defendant's structure, Plaintiff Exhibits 1, 3, 5, 7, 9, does

28. U.S.C. 35, Sec. 251.
29. Petitioner's patent, col. 3, lines 3-14.

not infringe Petitioner's patent because side walls do not rely on the principle of being distorted by the inflated tire. Rather Court says Defendant's structure uses an entirely different method to keep the side wall inwardly towards the tire. The new mode of operation being called a "lateral connecting bridge."

In the decision: Page 36, key 20; page 38, key 21.

The truth: First the Circuit Court concedes that Petitioner's claims read on Defendant's structure.[30] This leaves the question of whether or not the mode of operation is the same.

It is established in the brief for the Defendants on appeal that Defendant's structure and Barnes Patent No. 2,737,422[31] *are one and the same.* Counsel said:

> "Another Barnes application covering an improved side wall being made by Bearfoot, was filed December 19, 1955, and issued March 6, 1956, as Patent No. 2,737,422."

Referring to Fig. 6, above, if this view were blown up to a realistic size it could very well serve as the cavity mold drawing for Plaintiff's Exhibit No. 1.

Referring again to Barnes No. 2,737,422, Fig. 6, we see the following facts: 1. The skirt follows the rim flange around in an arcuate shape, and functions the same as Petitioner's arcuate cutout. 2. The main body portion has a before and after distortion position as shown by dotted lines in Fig. 6. This is also supported in the specifications by Barnes in the words: (Col. 1, lines 49-54)

> "Another object of the invention is to mold a side wall trim member to an initial shape so that it must be flexed to engage a tire and wheel assembly and to build forces in the trim member holding it resiliently against the tire sidewall."

This feature is further set forth in col. 3, lines 37-46.

The lateral connecting bridge which is supposed to be the new mode of operation was not thought enough of by Barnes

30. Decision, page 38, key 21.
31. Appendix 113A.

to illustrate. (See Fig. 4). This bridge is mentioned in the specification, however, in Col. 2, lines 14-16; Col. 5, lines 4-12, and is clearly defined as a means by which the side wall will bridge over raised lettering on the side of the tire. One could hardly say that this is the major principal of function of the side wall. Actually this disclosure by Barnes places the bridge in the role of a subordinate, secondary function.

Your Petitioner now respectfully asks the Court to study Plaintiff's Exhibits 1, 3, 5, 7, 9, and compare the operative, after distorted condition and shape with that of the pre-distorted shape as found in cross-sectional cuts Plaintiff's Exhibits 2, 4, 6, 8, 10. Also by placing the skirt of one of these cuts between the thumb and forefinger and pushing on the body portion, there is an enlightenment of mode of operation that transcends any number of words.

It is possible that the Defendants improved the side wall by removing a cut of rubber on the inside of the hump to accommodate the evolving shape of the tire casing as in tubeless tires, but there is no support in law or equity that a subsequent improvement invalidates or escapes infringement of the basic prior patent.

Nor does the fact that Defendant's side wall is smaller radially, and terminates inwardly of the widest bulge of the tire. This is merely keeping abreast of trends in white side wall taste.

The modes of operation are the same and infringement is present in this case.

Error 11: The holding by the Circuit Court that the phrases "turned inwardly," "curved inwardly," "defining a plane that is axially inwardly . . .", are all equivalent.

In the decision: Pages 26 and 27, key 22.

The truth: Although the above errors are not directly damaging to the patent's validity, they do infer some adverse points. What is significant about the statements cited above are that they give us an insight into the Circuit Court's mind and may well be the key to most of the errors in the decision.

The Circuit Court has stated that all the phrases are equivalent. If taken literally and given a broad construc-

tion, the phrases may have a similarity, but these phrases are used in patent claims and they must be interpreted in the light of the disclosure of the specification and drawing. Taken in this manner then the phrases have an entirely different meaning and it's quite believable at this point to think that perhaps the Circuit Court never looked beyond the literal meaning of the phrases.

Error 12: (Generally comprising) There are other errors that are in opposition to the truth such as contradictions within the decision itself,[32] misquotes and quotes out of contex.

There is one that is noteworthy that sets the tone of improvidence inherent in the decision. Claims 10, 11, 12, reproduced in the decision, page 20, key 24, completely omitted the patentable heart of the claim. the qualifying phrase. This error is compounded in a statement on page 27, key 25, in which Circuit Court contends that "curved inwardly" was qualifying phrase in lieu of true phrase decision omitted. This second error was to support a third, the false premise that "curved inwardly" defined distortion.

One need only to notice the correlation between the errors cited and the question of validity and infringement to determine whether or not they are crucial.

Facts re. Question 2

This is in reference to the statement by the Circuit Court as found on page 5, key 26, of the decision which infers that an inventor who does not actually produce and test his invention for operativeness does not have a valid patent.

In-opposition:

1. When the inventor discloses his invention he does so on good faith that U.S. Patent Office does not require actual reduction to practice and the application is considered constructive reduction to practice, and sufficient. If after he has disclosed with this understanding, he finds that later a Court invalidates the patent on the grounds that it is a paper patent, then the U.S. Government who *encouraged* him to

32. In decision, compare statement on page 12, key 5, with page 35, key 23.

disclose, has done so under false pretenses. Inventor faithfully relied on the wording of the statute.

2. The Circuit Court states in this same paragraph that Defendants spent a great deal of money. Courts statement about paper patent raises a surprisingly new question in that Plaintiff never expected Court to take this position. Perhaps it is important, then, to establish the fact that the Petitioner was, and is, of low income,[33] and had borrowed money to the limit of his means to have a mold made to provide the side wall. As they often do, the mold proved faulty and Petitioner was forced to look for other means of innovating invention.

Surely the patent grant was not intended to be available only to those wealthy enough to sustain development and testing for this is not equity.

3. At a time when technology and invention are being directed at the depths of the ocean or the far reaches of space, it is unrealistic to insist that the inventor must produce and test for operativeness in order to qualify for protection for his contribution. In many instances, as in the fields above, it would cost millions to produce and be impractical to test the invention.

4. U.S.C. 35, Sec. 114 states: "The Commissioner may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of the invention." Rule 91, of Rules of Practice of the U.S. Patent Office states, that if the specification and drawing disclose how to make the invention,[34] a model will not be admitted unless called for. If a model is not called for it should be safe to presume that constructive reduction is enough. Therefore the statutes are clear, constructive reduction is acceptable if no request is made by the Patent Office to provide a model. In the past the Supreme Court has held that the Courts should be controlled by the language of the statutes.

If the invention is operative and available for licensing, no *further* benefit would go to the public by the inventor producing his invention.

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33. Present annual gross income—highest to date—is approximately $6400.00 for a family of six.

34. Defendants made structure as taught by Petitioner's patent which was found operative by both lower courts.

In regards to constructive reduction to practice, the Supreme Court said in: *The Telephone Cases*, 31 L Ed. 863. (1888)

> "It is enough that he described his method with sufficient procesion to enable the skilled in the matter to understand what the process is . . ."

Facts re. Question 3

The number of times that the Circuit Court has used comments by the Examiner to support its own erroneous contentions are so numerous[35] that it brings into this present case a factor that could have very serious consequences if allowed to remain uncorrected.

The Circuit Court held, and wrongly so, that the phrase, "turned inwardly," or "curved inwardly" defined a structure that lends to distortion. This was the basic error in the Circuit Court's determinations and involved such crucial matters as anticipation and validity. The Circuit Court used the words of the Examiner to lend support and add weight to its findings.

As pointed out earlier, peripheries turned or curved inwardly do not define a side wall that lends to distortion, therefore the Circuit Court's findings were based on a false premise. This is true, also, of the Examiner who was reversed by a second ruling of the Board of Appeals.[36] It is significant to note that the Board consisted of two Examiners in Chief and one Primary Examiner. Regarding matters of patents, then, this is about as experienced and competent as one could find. The actions of the Board of Appeals were for naught, however, and it was the words of the Primary Examiner that were controlling in this case although said words were proven wrong. The potential drawbacks of such a practice by Circuit Court of Appeals are clear as pointed out in the latter part of the following section.

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35. Decision, page 14 and 15, key 27; pages 17 and 18, key 28; page 21, key 29; page 22, key 30.
36. Appendix 99A.

REASONS FOR GRANTING THE WRIT OF CERTIORARI

There is a disconcerting note about the decision of the Circuit Court. When one reads, for example, the decision and makes a superficial examination of the matter, one gets the impression that the Circuit Court had discharged its duty with the upmost prudence. It took almost a year to hand down the decision which numbered thirty-nine pages, and the Circuit Court commented extensively on the file wrapper, etc. It would appear indeed that the Circuit Court had done a very thorough job. But words and time of this nature are relatively easy to come by. What is required is patient research into the documents of record and devotion of time to understand the truth and significance therein when quite often the truth is clouded by the arguments of the counsel. This is not an easy chore and would probably prove frustrating and overtaxing for most men. But judges are not ordinary men. They are expected and intrusted to have the fortitude to expend the effort necessary to render a just decision.

Looking, then, at the decision by the Circuit Court and comparing its findings with the real truth as found in the record, one can only conclude that the Court did not act with propriety. It did not, it could not have, investigated the documents of record adequately, and therein, barring some unforeseen or unknown circumstances, lies the cause for an extremely unbelievable, erroneous decision by a Circuit Court.

To say, for example, that the term, "turned inwardly," as used in the Barnes No. 1 defines a structure that lends to distortion by the inflating tire is wanting for rational logic and defies understanding. And the statement that the Defendant's structure functions under a completely new and different principle than distortion in the face of an examination of Plaintiff's Exhibits 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, is surely indicative of a lack of investigation.

The source of the erroneous findings are quite obvious, for in the areas that are most crucial, the Circuit Court adapted, apparently without question, the arguments by the counsel for the Defendants.

The Circuit Court criticized, subtly, the Trial Court's adaptation of counsel's Finding of Fact and Conclusions of Law in favor of the Plaintiff. Yet the Trial Court had received the facts first hand and the Trial Judge was observed dutifully taking notes throughout the trial. The Circuit Court, relying on the arguments of counsel, without self-determination from the record, reversed the Trial Court.

So now your Petitioner is seeking a final judgment on the truth and respectfully evokes the responsibility of this Court, endowed by its very creation to either sanction or disavow actions taken by the lower Courts of the land. This guardianship of the lower Courts is found in Article III, Sec. 1, of the Consttution which says that judicial power shall be vested in *one* Supreme Court, a concept which is also supported and strengthened by the statutes on jurisdictional review. It is hard for your Petitioner to imagine the Supreme Court, having the responsibility of manifesting the wisdom of the Constitution, approving of the method used by the Circuit Court to adjudge this case.

We must ask ourselves, then, is this to be acceptable as judicial procedure, to rely on the convincibility of the arguments of counsel rather than to seek the truth through self-determination from the facts. Because if it is, the courts would soon be reduced to mere literary reviewers and justice would become a term to describe a grant to those fortunate enough, and eventually powerful enough (for the process would be self-accelerating) to hire the more literarily inclined, astute, and often deceptive counsel. A seed of decline would surely have taken root.

Regarding Question 2, the question of whether or not a valid patent is dependent on actual or constructive reduction to practice, the statutes are clear and the courts should be controlled by the statutes and not try to re-write them. The Supreme Court has recognized this and previously cited the dangers in the courts usurping the responsibilities of Congress.

In a period when technological advance in producing inventions that cannot feasibly be produced and tested, it is *timely* that the Supreme Court set guide lines whether actual or constructive reduction to practice is required for a valid

patent. If actual reduction is called for, the statutes should be changed to concur so that the inventor will not be lulled into a false sense of security when he discloses his invention. There is a definite *statutory conflict* here between the Courts and the Patent Office.

And finally the practice of the Circuit Court using words and arguments of a Primary Examiner to assist in invalidating a patent when said words were wrong and reversed by a Board of Appeals. This may seem petty and trifling, but if this Circuit Court can apply this practice, who can say where it will end. As pointed out earlier the whole line of appeal in the Patent Office is eroded if not the patent system itself. Without an effective line of appeal in the Patent Office *single* Examiners would have the power of patentable life and death over invention. This is fertile ground for corruption and the whole patent system is in danger.

The patent system has been under assault from various quarters, but primarily from intellectuals who deal mostly in abstract concepts. The intellectual community may well be the saving force in this nation, (it was the same type of men that wrote the Constitution) but their criticism to date has not provided a concrete working alternative to the present patent system. For all its faults, the patent and the copyright systems are all we have to protect the fruits of creative mental effort, not to mention the incentive value, and perhaps we shouldn't foresake them at this time for a hypothesis.

To say that decline and decadence would follow this one erroneous decision by the Circuit Court would be an affront to the Supreme Court, but history tells us that downfalls have started less quietly, and if we are ready to ***knowingly*** compromise judicial integrity, it is later than we think.

The question naturally arises which is pertinent: Is there foundation in the foregoing for the above statements, or is the Petitioner being a self-serving alarmist? The Petitioner, of course, is seeking equitable relief, but material things are for naught when the environment for the pursuit of happiness is lost. As a father of four, concern for the future is natural.

CONCLUSION

It is prayed that in view of the foregoing, the Supreme Court will see the need for reviewing this case.

Respectfully submitted,

BRYAN W. NICKERSON, JR.
Petitioner

CERTIFICATE OF SERVICE

I hereby certify that three copies of the above were this day of , 1963, mailed to Ely, Frye, and Hamilton, Everett Hamilton, Bernard C. Frye, and Mack D. Cook II, 2505 First National Tower, Akron, Ohio; attorneys for Defendants - Respondents.

BRYAN W. NICKERSON, JR.